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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/058,643	01/28/2002	Anthony Nocella III	984	3850

7590 12/17/2004

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202 Delaware Building  
137 South Main Street  
Akron, OH 44308

EXAMINER
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YIP, WINNIE S

ART UNIT	PAPER NUMBER
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3637

DATE MAILED: 12/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/058,643

Applicant(s)

NOCELLA, ANTHONY

Examiner

Winnie Yip

Art Unit

3637

*NY*

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                                                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

### DETAILED ACTION

In view of the applicant's brief filed on September 20, 2004, PROSECUTION IS HEREBY REOPENED. A new ground of rejections set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### *Claim Rejections - 35 USC § 102*

1. Claims 1-2 stand rejected under 35 U.S.C. 102(b) as being anticipated by Chou et al. '536.

Chou et al. show and disclose an umbrella comprising: a shaft (2), a retractable head inherently including an umbrella frame (41, 42) being operated together with the shaft to alternately extend, lock, and retract the retractable head relative to the shaft, said shaft (2) having a shaft lower end, a handle section (1) affixed to the shaft lower end, an illumination means including a refractor (5) and a light source such as a lamp (3) being affixed to the handle section, said handle section having an inside cavity, a battery assembly (64) being housed within the inside cavity at an upper end of the handle section, the lamp (3) is also housed within the

inside cavity of the handle section (1), and handle section having a lower portion providing a screw cap having receiving threads to mate with threads formed along the lower rim of an upper portion of the handle section such that to removably contain the batteries (see Fig. 2), and a switch (63) for on/off the illumination means, wherein the shaft is a transparent, solid, polygonal rod with a refracting area for refracting the light source and therefore the whole umbrella body is illuminated.

2. Claims 1-2 are rejected under 35 U.S.C. 102(b) as being anticipated by Tatsumi '831.

Tatsumi shows and discloses an umbrella comprising a tubular shaft (2) having a shaft lower end, a retractable head including an umbrella frame inherently including ribs (23), a hub (22), and a runner being operated together with the shaft to alternately extend, lock, and retracted the retractable head, a handle section (3) affixed to the shaft lower end, illumination means affixed to the handle section for furnishing the rays of light which illuminate the shaft, said handle section having a cavity, said illumination means including a light source which may be a visible ray LED (7) or a light bulb (12) and a battery assembly (4 and 5) being housed within the cavity of the handle section, and the shaft being made of hard synthetic resin which could be a light permeable, colored transparent, or milky white tube through the entire shaft (2) or spaced apart members (27) that circumscribing the shaft for transmitting rays of light.

***Claim Rejections - 35 USC § 103***

3. Claims 3 and 5-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chou et al. '536 or Tatsumi '831 as applied to claim 1 above, and further in view of Murphy '805.

The claims are considered to meet by Chou et al. or Tatsumi as explained and applied in above rejections except that either Chou et al. or Tatsumi does not specifically disclose the illumination means such as the lamp or light bulb being an incandescent lamp as claimed. However, Murphy teaches an umbrella (20) comprising an illumination means including a light source (28) mounted on the shaft (22), wherein the light source (28) would be an incandescent light bulb to provide colored light source and greatly reduce luminosity of the light bulb for improving the visibility of the user and reducing the time of the light source to be used (col. 4, lines 32-48). Since applicant has not disclosed that the umbrella having a light source being an incandescent lamp provides an advantage, is used for a particular purpose, or solves a stated problem, and an incandescent lamp is well known in the art being used as a light source as taught by Murphy. Therefore, it would have been an obvious matter of design choice to a person of ordinary skill in the art at the time the invention was made to modify the light source of the umbrella of either Chou et al. or Tatsumi being perform equally well with an incandescent lamp as an obvious matter of design choice of a light source as taught by Murphy for improving the visibility of the user.

4. Claims 4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chou et al. '536 or Tatsumi '831 as applied to claim 1 above, and further in view of Carso et al. (US Patent No. 6,237,615).

The claims are considered to be met by Chou et al. or Tatsumi as explained and applied in above rejections except that either Chou et al. or Tatsumi does not specifically disclose the umbrella comprising the shaft having a circumscribing portion being formed by a translucent,

neon-colored tube as claimed. However, Chou et al. has disclosed the shaft (2) of the umbrella would be formed of a transparent polygonal rod with a plurality of grooves (20) and at least a refracting area (21) circumscribing the shaft for transmitting light source outwardly. And, Tatsumi has disclosed the shaft (2) of the umbrella would be formed of a hard synthetic resin and, at least an area (27) or an entire area between a lower stopper (9) and an upper stopper (10), being formed of light permeable colored transparent member or milky white member for allowing light from the illumination means emitted outwardly. Further, Carso et al. teach an umbrella (100) comprising a shaft (30) being made of transparent or translucent material to increase the illumination for outwardly emitting light source, an activated light-stick. Therefore, it would have been an obvious matter of design choice to a person of ordinary skill in the art, at the time the invention was made, to modify the umbrella of either Chou et al. or Tatsumi having the umbrella shaft including a part of the shaft being selectively formed of a translucent, neon-colored tube with circumscribed portion along the shaft as claimed because Applicant has not disclosed that the shaft being formed with a specific material such as translucent, neon-colored tube provides an advantage and is used for a particular purpose, or solves a stated problem. One of ordinary skill in the art, furthermore, would have expected applicant's invention to perform equally well with the shaft of the umbrella of either Chou et al. or Tatsumi having selected light permeable material such as colored transparent member or milky white member as taught by Chou et al. or Tatsumi or a translucent, neon-colored as claimed as taught by Carso et al. because all light permeable members perform the same function of allowing light source to be emitted outward to achieve the result for improving more visibility of a user.

*Response to Arguments*

5. In response to applicant's argument that the rejections of claims 1-2 under 35 USC 102 as being anticipated by Chou et al. '536 or Tatsumi '831 are inappropriate because of Chou et al. '536 and Tatsumi '831 fail to show the umbrella having a translucent, neon-colored tube circumscribing the shaft of the umbrella as claimed, it is not deemed persuasive. Notice, there are only claims 1-2 being rejected under 35 U.S.C. 102 (b) by Chou et al. or Tatsumi but not claims 1-5 and 7. It is noted that the features upon which applicant relies (i.e. a translucent, neon-colored tube circumscribing the shaft of the umbrella) has not been recited in the rejected claims 1-2. This feature is only recited in the non-rejected claims 4 and 7 (which are rejected under 35 U.S.C. 103 statute). Anticipation is established when a single prior art reference discloses, expressly or under principles of inherency, each and every element of a claimed invention. *RCA Corp. v. Applied Digital Data Sys., Inc.*, 730 F.2d 1440, 221 USPQ 385, 388 (Fed. Cir. 1984). It is not necessary that the reference teach what the subject application teaches, but only that the claim read on something discloses in the reference, i.e., that all of the limitations in the claim be found in or fully met by the reference. *Kalman v. Kimberly Clark Corp.*, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026 (1984). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). In this application, the recited references are considered to show and disclose all structural limitations recited in the claims including a retractable head, a

shaft, a handle section, and an illumination means only. See the discussion set forth rejections.

6. In response to applicant's argument that there is no suggestion to combine the references of Chou et al. '536 or Tatsumi '831 in view of Murphy '805 and Carso et al. '615 as rejected under 35 U.S.C. 103 (a) status, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, all references teach a same art of an umbrella having a light source. Tatsumi further discloses the shaft (27) being tubular shaft made of light permeable material which may be milky white hard synthetic resin (see col. 4, line 41) which is substantially equal to translucent, neon-colored. Since applicant does not specifically define a light source having an incandescent lamp which provides an advantage and is used for a particular purpose, or solves a stated problem, Murphy is used as a reference to teach an umbrella of Chou et al. or Tatsumi would be perform equal well with the light source being selectively replace by an incandescent lamp as claimed, Carso et al. is used as a reference to teach the umbrella of Chou et al. or Tatsumi would provide the shaft formed form translucent, neon-colored tube instead of transparent colored tube to solve the same problem for providing extremely bright illumination, reducing luminosity of the light bulb and safe time of use, as well known in the art, for improving the visibility of the user.

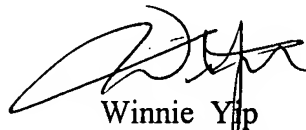


*Inquiry Contacts*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Winnie Yip whose telephone number is 703-308-2491. The examiner can normally be reached on M-F (9:30-6:30), Second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Winnie Yip  
Primary Examiner  
Art Unit 3637

wsy  
December 13, 2004